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09/699,037	10/27/2000	Steven G. Doughty	5053-31401/EBM	6766

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ERIC B. MEYERTONS  
CONLEY, ROSE & TAYON, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398

EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/699,037

Applicant(s)

DOUGHTY, STEVEN G.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6 and 7.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-31 and 78 are pending.
2. The Preliminary Amendment A filed 03/07/01 canceling claims 32-77 and 79-94 has been entered as paper no. 4.
3. The Power of Attorney filed 06/25/01 has been entered as paper no. 5.
4. The IDS filed 07/12/02 has been entered as paper no. 6 and the IDS filed 11/06/03 has been entered as paper no. 7.

### ***Claim Objections***

5. Claims 1, 21, 26, and 31 are objected to because of the following informalities: Claim 1 has the acronym "FSO" in the body of the claim and does not have what "FSO" stands for in line 10 of the claim. The claim should read "Financial Service Organization (FSO)". Claims 21, 26, and 31 have a similar problem. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1, 2, 6, 21, 22, 26, 27, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, lines 13-21 read "wherein the computer system is configured to receive a first FSO transaction-related data, wherein the computer system is configured to read the selected plurality of field identifiers ..., wherein the computer system is configured to access and read a first

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processing parameter ..., and wherein the computer system is configured to process the first FSO ....". This is very vague and confusing with so many limitations beginning with "wherein". This makes the claim language redundant. Claims 6, 21, 22, 26, 27, and 31 have a similar problem.

8. Claim 2, page 36, line 5 contains a conditional statement. It is unclear what happens "if the first data does not compare equally to the FSO transaction-related data contained in the fields of the first FSO ...". Clarification in the claim language is respectfully requested.

9. Claims 6-20, 31, and 78 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

A. Claims 6, 31, and 78 are not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claim refers to a method, but the body of the claim discusses the specifics of the system of a Financial Service Organization (FSO) (ex. displaying one or more key elements, and selecting one or more key element representations), and subsequently the claim then deals with the specifics of a method (the steps ex. preparing a key definition from the one or more key elements, storing the key definition, configuring the key definition stored in a database for use in preparing a processing key value from a transaction related data) in a FSO computer system.

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B. Claims 7-20 are rejected as being dependent on claim 30 as discussed above.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 6-20, 31, and 78 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claims 6, 31, and 78), the body of the claim discusses the specifics of the system of the Financial Service Organization (FSO), and subsequently the claim then deals with the specifics of a method (the steps) performed by the Financial Service Organization (FSO) (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). “A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only”, Ex parte Lyell (17 USPQ2d 1548).

The method claims appear to be directed more toward system claims than method claims.

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Suggestion: Claim 6 should read "A computer-implemented Method" in order to determine that the steps are performed by a computer. Claims 31 and 78 have a similar problem. A computer, a network, or a machine must be in the preamble and the body of the claim to perform the method in order for the claim to comply with being technological and patentable.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-5 and 21-30 are rejected under 35 U.S.C. 103 (a) as being unpatentable over (US 5,907,848) Zaiken et al, hereafter Zaiken in view of (US 5,864,679) Kanai et al, hereafter Kanai.

As per claims 1, 21, and 26, Zaiken teaches, A method of configuring a computer system for receiving and processing Financial Service Organization (FSO) transaction-related data, wherein each FSO transaction-related data is defined by a plurality of fields, each of which contains the FSO transaction-related data, the method comprising: displaying a plurality of field identifiers on a display screen of a monitor, wherein the monitor is in data communication with the computer system, a first memory, and a second memory, wherein each of the displayed field identifiers identifies a respective field in each of the FSO transaction-related data; selecting a plurality of the

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displayed field identifiers (col. 5, lines 46-56, col. 6, lines 5-25, and fig. 1 and 2); storing the selected plurality of field identifiers in the first memory (col. 6, lines 5-9, col. 7, lines 53-67, col. 8, lines 1-27, and col. 11, lines 1-3). Zaiken failed to teach, wherein the computer system is configured to receive a first FSO transaction related data, wherein the computer system is configured to read the selected plurality of field identifiers from the first memory in response to the computer system receiving the first FSO transaction-related data, wherein the computer system is configured to access and read a first processing parameter from the second memory using FSO transaction related data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, and wherein the computer system is configured to process the first FSO transaction-related data and the first processing parameter.

Kanai teaches, wherein the computer system is configured to receive a first FSO transaction related data, wherein the computer system is configured to read the selected plurality of field identifiers from the first memory in response to the computer system receiving the first FSO transaction-related data, wherein the computer system is configured to access and read a first processing parameter from the second memory using FSO transaction related data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, and wherein the computer system is configured to process the first FSO transaction-related data and the first processing parameter (col. 1, lines 31-39, col. 15, lines 8-62, col. 17, lines 58-67, col. 18, lines 1-18, and col. 19, lines 14-38). It would

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have been obvious to one having ordinary skill in the art at the time the invention was made to have a computer system configured to receive a first FSO transaction related-data, wherein the computer system is configured to read the selected plurality of field identifiers from the first memory in response to the computer system receiving the first FSO transaction-related data, wherein the computer system is configured to access and read a first processing parameter from the second memory using FSO transaction - related data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, and wherein the computer system is configured to process the first FSO transaction-related data and the first processing parameter and to modify in Zaiken in view of Zaiken's teachings of field identifiers and key values because such a modification would allow Zaiken to have a transaction processing system for executing some kind of processing for transactions received from transaction sources.

As per claim 21, Zaiken teaches, a computer program (col. 6, lines 1-2) and a computer system (col. 6, lines 2-5) to perform the steps of claim 21.

As per claim 26, Zaiken teaches, a carrier medium comprising program instructions (col. 6, lines 2-13) to perform the steps of claim 26.

As per claim 2, Zaiken teaches, The method of claim 1, further comprising: displaying a template on the monitor, wherein the template comprises a plurality of fields for receiving data values (10, lines 60-67 and col. 11, lines 1-5); entering a first data in a first field of the template (col. 7, lines 42-52); entering the first processing parameter in a second field of the template (col. 7, lines 53-59); storing the first



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processing parameter and the first data in the second memory; wherein the computer system is configured to compare the first data stored in the second memory with the FSO transaction-related data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, and wherein the computer system is configured to access and read the first processing parameter if the first data compares equally to the FSO transaction related data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory (col. 9, lines 26-41 and col. 10, lines 20-34).

As per claim 3, Zaiken failed to teach, The method of claim 1, further comprising: preparing a first processing key value from data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, wherein the computer system is configured to access and read the first processing parameter from the second memory using the first processing key. Kanai teaches, preparing a first processing key value from data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, wherein the computer system is configured to access and read the first processing parameter from the second memory using the first processing key (col. 23, lines 28-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare a first processing key value from data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, wherein

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the computer system is configured to access and read the first processing parameter from the second memory using the first processing key. Kanai teaches, preparing a first processing key value from data contained in fields of the first FSO transaction-related data that are identified by the selected plurality of field identifiers read from the first memory, wherein the computer system is configured to access and read the first processing parameter from the second memory using the first processing key and to modify in Zaiken because such a modification would allow Zaiken to have a type of transaction with fields for registering the type of transaction and a value indicating the type of transaction.

As per claim 4, Zaiken failed to teach, The method of claim 3, wherein the first processing key value is defined by a plurality of fields which contain copies of data from the fields of the first FSO transaction-related data identified by the selected plurality of field identifiers read from the first memory. Kanai teaches, wherein the first processing key value is defined by a plurality of fields which contain copies of data from the fields of the first FSO transaction-related data identified by the selected plurality of field identifiers read from the first memory (col. 44, lines 18-31 and lines 60-67 and col. 45, lines 1-3 and lines 24-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first processing key value is defined by a plurality of fields which contain copies of data from the fields of the first FSO transaction-related data identified by the selected plurality of field identifiers read from the first memory. Kanai teaches, wherein the first processing key value is defined by a plurality of fields which contain copies of data from the fields of the first FSO

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transaction-related data identified by the selected plurality of field identifiers read from the first memory and to modify in Zaiken because such a modification would allow Zaiken to have a correlation of the information table or a copy of the correlation of the information table taken by the correlation management table and transmit the data arrangement to the determination unit.

As per claim 5, Zaiken failed to teach, The method of claim 4, further comprising: entering mapping data into the computer system, wherein the mapping data maps each of the selected plurality of field identifiers to a respective field of the first processing key value, wherein the computer system is configured to place data from each of the fields of the first FSO transaction-related data identified by the selected plurality of field identifiers into a respective field of the processing key value in accordance with the mapping data. Kanai teaches, entering mapping data into the computer system, wherein the mapping data maps each of the selected plurality of field identifiers to a respective field of the first processing key value, wherein the computer system is configured to place data from each of the fields of the first FSO transaction-related data identified by the selected plurality of field identifiers into a respective field of the processing key value in accordance with the mapping data (col. 48, line 55-67 and col. 49, lines 1-2 and lines 58-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to enter mapping data into the computer system, wherein the mapping data maps each of the selected plurality of field identifiers to a respective field of the first processing key value, wherein the computer system is configured to place data from each of the fields of the first FSO transaction-related data

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identified by the selected plurality of field identifiers into a respective field of the processing key value in accordance with the mapping data and to modify in Zaiken because such a modification would allow Zaiken to transmit the process ID, the data ID, the parameter for distinguishing the processing and use of the received data ID as the key for the index of the tree structure (mapping the data).

As per claim 22, This dependent claim is rejected for the similar rationale as given above for claim 2.

As per claim 23, This dependent claim is rejected for the similar rationale as given above for claim 3.

As per claim 24, This dependent claim is rejected for the similar rationale as given for claim 4.

As per claim 25, This dependent claim is rejected for the similar rationale as given for claim 5.

As per claim 27, this dependent claim is rejected for the similar rationale as given above for claim 2.

As per claim 28, this dependent claim is rejected for the similar rationale as given above for claim 3.

As per claim 29, this dependent claim is rejected for the similar rationale as given above for claim 4.

As per claim 30, this dependent claim is rejected for the similar rationale as given above for claim 5.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brandt et al (US 5,892,905) disclosed accessing different application programs.

Perlman & Castagnoli (EP 0 836779B1) disclosed synchronizing information over a network.

### ***Inquiries***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
July 24, 2004